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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,184	06/26/2003	David L. Patton	83891AF-P	6177

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Milton S. Sales  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

LE, BRIAN Q

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/607,184

Applicant(s)

PATTON ET AL.

Examiner

Brian Q. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **Response to Amendment and Arguments**

1. Applicant's amendment filed January 01, 2005, has been entered and made of record.
2. The double patenting rejection is withdrawn.
3. The rejection of claims 2-5, and 7 under 35 USC 112, first paragraph is now withdrawn because the Applicant still does not provide two separate enablement for the and/or limitation of the claims. Please refer to 35 USC 112 rejection below for further detail.
4. Applicant's arguments with regard to claims 1-8 have been fully considered, but are not considered persuasive because of the following reasons:

For claim 1, the Applicant argues (page 5) that Kaplan reference does not teach the reading a micro-discrete indicia on a gemstone because the present invention is directed to a reading indicia as stated by the Applicant (page 5) is substantially smaller in size by magnitudes comparing to Kaplan Reference since the present application is dealing with indicia size no greater than 20 micron and Kaplan is dealing at the nanometer scale. The Examiner would like to invite the Applicant to re-study the metric system. First, nanometer is one billionth of a meter and micrometer is one millionth of a meter as clearly defined by Merriam-Webster Online. The Examiner is also providing the copies of the definition for the Applicant to further study these fundamental concepts. Second, the Applicant never specify the limitation to a range of 2-20 microns or no greater than 20 microns. Thus, the Examiner does not obligate to include the precise range into the limitation. Third, Kaplan also dealing with indicia read in the micrometer scale (column 8, lines 50-55 and column 16, lines 45-50). Thus, it is quite clearly that Kaplan is the appropriate art that teaches this limitation.

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The Applicant also argues (bottom of page 5) that Kurihara Reference cannot be combine with Kaplan reference because Kurihara Reference is directed to fabrication and the near-field probes tools are use to investigate non-linearity on the near-field region. Diamond clearly is a non-linear object of the fabrication/manufacturing process. Thus, Kurihara Reference is teaching similar field/art of invention.

Regarding the claim 3, the Applicant argues (page 6) that Kaplan does not teach the locating the indicia using predetermined coordinates. The Examiner respectfully disagrees. Kaplan clearly teaches the providing of position (locating) using predetermined coordinates whether X, Y, Z or other coordinate systems to generate the inscription on the gemstone (column 4, lines 48-60) which is to inscribe indicia on the surface of gemstones (column 1, lines 13-16).

Thus, the rejections of all of the claims are maintained.

### ***Specification***

5. The amendment filed January 01, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The concept of locating indicia using the normal optical microscope **and/or** eye loop is consider to be new matter and thus cannot be added into the disclosure of the invention.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2, 5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claim 2, the Applicant must provide **two separate enablement (two separate supports)** in the original disclosure for a method wherein said micro-discrete indicia is located initially located using an eye-drop **and** a microscope and for another method wherein said micro-discrete indicia is located initially located using an eye-loop **or** a microscope. Similarly, the same rejections are made for claims 5 and 7 because of its **and/or** limitation.

Claims are not specifically addressed depend from indefinite antecedent claims.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kaplan U.S. Patent No. 6,211,484 and further in view of Kurihara et al. "Fabrication of Functional Probes for Near-field Optic Microscopy", Lasers and Electro-Optics, 1997 pages: 148-149.

Regarding claim 1, Kaplan teaches a method for reading a micro-discrete indicia (comparison between reading indicia and retrieved metric at micron scale) (column 8, lines 50-55 and column 16, lines 45-50) on gemstone (column 1, lines 13-15) comprising the locating said micro-discrete indicia on said gemstone (measuring gemstone's characteristics and locating indicia by coordinate) (column 8, lines 50-65 and column 4, lines 45-50). However, Kaplan does not explicitly teaches the reading of micro-discrete indicia using near-field optics. Kurihara teaches a material measurement (material reading)/polymer utilizing near-field optical microscopy (page 148, 2<sup>nd</sup> column, first 2 paragraphs). Modifying Kaplan's method of providing micro-discrete indicia on gemstone would be able to provide the reading (measurements) of micro-discrete indicia using near-field optics. This would improve processing and therefore, it would have been obvious to one of the ordinary skills in the art to modify Kaplan according to Kurihara.

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Regarding claim 2, Kaplan teaches a method wherein said micro-discrete indicia is located (as discussed) initially located using an eye-loop (jeweler's loupe) (column 8, lines 30-35) and/or microscope (FIG. 6, element 68).

For claim 3, Kaplan further teaches a method wherein said micro-discrete indicia is located by using predetermined coordinates (initially positioned) associated with the characteristics of said gemstone (column 4, lines 48-60) (column 1, lines 13-16).

Referring to claim 4, Kaplan also teaches a method where a document (column 8, lines 14-18 and column 4, lines 13-21) is provided that designates the appropriate coordinates of the micro-discrete indicia of said gemstone (column 4, lines 48-60).

Regarding claim 5, Kaplan teaches a method wherein said characteristics of said gemstone is selected from of the following size (column 13, lines 31-37).

For claim 6, Kaplan discloses a method wherein said micro-discrete indicia is used for authenticating an occasion of said gemstone (column 13, lines 34-47).

Referring to claim 7, Kaplan teaches a method wherein said authentication identifies the quality and/or type of gemstone (face value) (column 6, lines 60-64).

For claim 8, Kaplan further teaches the scanning said gemstone (microscope scans gemstone) (FIG. 6, element 68).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


***Contact Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 571-272-7424. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 571-272-7414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-5397 for regular communications and 703-308-5397 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

BL  
June 17, 2005



**SAMIR AHMED  
PRIMARY EXAMINER**



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